

REMARKS

This is a response to the Office Action dated March 24, 2006 in the above-referenced patent application. Claims 1-15 are pending in the above-referenced patent application.

Claims 1, 3 and 5 have been amended to correct minor typographical errors. Claim 2 has been added to further clarify the claimed limitations. New matter has not been added.

All of the claims were rejected. Specifically, claims 1-4, 6-8 were rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (USPN 6,698,020).

Claims 5, 12-13 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of U.S. Patent Application publication 20020010927 (Kim).

Claims 9-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of U.S. Patent Application publication 20040073947 (Gupta), and further in view of Dimitrova (USPN 6,469,749).

Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Kim, and further in view of Gupta and Dimitrova.

Rejections of claims 1-15 is respectfully traversed because at least for the following reasons the references, alone or in combination, do not disclose all of the claimed limitations.

Claim Rejections Under 35 U.S.C. 102(e)

Rejection of claims 1-4, 6-8 under 35 U.S.C. 102(e) as being anticipated by Zigmond is respectfully traversed because Zigmond does not disclose all of the claimed limitations.

As per **Claim 1**, Zigmond does not disclose providing a digital television receiver performing a Digital TV function, storing a plurality of advertisement messages in a storage device, using the digital television receiver to receive video data from a digital television service provider, outputting the plurality of the advertisement messages and the received video data with the digital television receiver, and if a predetermined number of the plurality of the advertisement messages has been output, then disabling the digital TV function of the digital television receiver, as required by Claim 1.

The Examiner's interpretation of Zigmond is respectfully traversed. For example, despite the Examiner's interpretation, element 60 in fig. 3 of Zigmond (col. 7, lines 37-67) is an AD insertion unit that simply inserts advertisements, not a digital television receiver performing a Digital TV function, as claimed.

Despite the Examiner's interpretation, element 84 in fig. 5 of Zigmond (col. 15, lines 17-34) is an AD filter used to pre-screen and accept only selected advertisements from the ad delivery source, and does not store any ads and does not disclose: storing a plurality of advertisement messages in a storage device, as required by Claim 1.

Despite the Examiner's interpretation, element 62 in fig. 4 of Zigmond (col. 8, lines 1-11) is an AD source, not a storage device, that provides an advertisement stream to multiple households via channels from a central location, and does not disclose: storing a plurality of advertisement messages in a storage device, as required by Claim 1.

Element 66 in Zigmond (col. 8, lines 29-38; col. 7, lines 1-25) is a programming source, but despite the Examiner's interpretation, element 66 does not disclose: *subsequent to* storing the plurality of the advertisement messages, using the digital television receiver to receive video data from a digital television service provider, as required by Claim 1.

Despite the Examiner's interpretation, element 58 in Zigmond (col. 8, lines 29-38) is a display monitor not a receiver, and further in Zigmond ads and video programming are toggled such that Zigmond does not disclose: *with the digital television receiver*, outputting the plurality of the advertisement *messages and the received video data*, as claimed.

Despite the Examiner's interpretation, element 61 in Zigmond does not disclose: if a predetermined number of the plurality of the advertisement messages has been output, then disabling the digital TV function of the digital television receiver, as required by Claim 1. Element 61 in Zigmond is a statistics collection location, and in col. 13, lines 40-47 (relied on by the Examiner), Zigmond states:

“In one embodiment, statistics collection location 61 of FIG. 5 counts the number of times a particular viewer has seen a selected advertisement. Once the advertisement has been displayed the desired number of times during a given time period, **further display of the advertisement to the viewer is blocked**. This is useful, for example, to prevent viewers from becoming frustrated through being excessively exposed to the selected advertisement.” (emphasis added).

As is glaringly obvious from the above-quoted passage, in Zigmond in order to prevent user frustration, further display of advertisements to a viewer is blocked while display of regular video programming continues. By contrast, as claimed herein, when predetermined number of the advertisement messages have been output, then the digital TV function of the digital television receiver is disabled such that unlike Zigmond regular video programming is disabled.

For at least these reasons, rejection of Claim 1, and all claims dependent therefrom, should be withdrawn.

As per **Claim 2**, Zigmond does not disclose: after the digital TV function has been disabled, storing a new set of the plurality of advertisement messages in the storage device, and subsequently enabling the digital TV function of the digital television receiver, as required by Claim 2. As discussed in relation to Claim 1, Zigmond (col. 13, lines 40-47) does not disclose

disabling output of regular programming to a viewer, and as such clearly Zigmond (col. 8, lines 29-39) does not disclose storing a new set of the plurality of advertisement messages in the storage device and then enabling output of regular programming to a viewer. In col. 8, lines 29-39, Zigmond only mentions that ads and regular programs are toggled by a switch 68 for display, and in no way discloses: storing a new set of the plurality of advertisement messages in the storage device storing a new set of the plurality of advertisement messages in the storage device, and subsequently enabling the digital TV function of the digital television receiver, as claimed.

As per **Claim 3**, Zigmond does not disclose: storing the new set of the plurality of the advertisement messages in the storage device by downloading the new set of the plurality of the advertisement messages from a network, as required by Claim 3. In col. 8, lines 29-37, Zigmond only mentions that ads and regular programs are toggled by a switch 68 for display, and in no way discloses storing a new set of the plurality of the advertisement messages, nor discloses downloading the new set of the plurality of the advertisement messages from a network and storing them in a storage device, as claimed.

As per **Claim 4**, Zigmond (col. 14, lines 49-58, relied on by the Examiner), does not disclose: setting the predetermined number such that all of the plurality of the advertisement messages that were stored will be output, as required by Claim 3. Zigmond only mentions that an advertiser may pay for a guaranteed number of exposures (which may be different for different

advertisers). However this does not teach setting the predetermined number such that *all of the plurality of the advertisement messages* that were stored will be output, as claimed.

As per **Claim 6**, Zigmond (col. 15, lines 17-34; col. 8, lines 1-11; relied on by the Examiner), does not disclose: providing the storage device as a component of the digital television receiver, as required by Claim 6. Despite the Examiner's interpretation, element 84 in fig. 5 of Zigmond (col. 15, lines 17-34) is an AD filter used to pre-screen and accept only selected advertisements from the ad delivery source, and does not store any ads and does not disclose providing the storage device as a component of the digital television receiver, as required by Claim 6. Despite the Examiner's interpretation, element 62 in fig. 4 of Zigmond (col. 8, lines 1-11) is an AD source, not a storage device, that provides an advertisement stream to multiple households via channels from a central location, and does not disclose: providing the storage device as a component of the digital television receiver, as required by Claim 6. Further, element 62 in fig. 4 of Zigmond is not part of the viewer's TV set, rather an AD source external to the viewer's location.

As per **Claim 7**, Zigmond does not disclose: storing the plurality of the advertisement messages by downloading the plurality of the advertisement messages from a network, as required by Claim 7. Despite the Examiner's interpretation, element 84 in fig. 5 of Zigmond (col. 15, lines 17-34) is an AD filter used to pre-screen and accept only selected advertisements

from the ad delivery source, and does not store any ads or downloading ads to a storage device, as required by Claim 6. Despite the Examiner's interpretation, element 62 in fig. 4 of Zigmond (col. 8, lines 1-11) is an AD source, not a storage device, that provides an advertisement stream to multiple households via channels from a central location, and does not disclose: downloading the plurality of the advertisement messages from a network and storing them in a storage device, as claimed.

As per **Claim 8**, Zigmond (col. 18, line 38 - col. 19, line 9, relied on by the Examiner), does not disclose: receiving additional video data from the digital television service provider; with the digital television receiver, outputting the additional video data without outputting the plurality of the advertisement messages; and limiting a duration that the step of outputting the additional video without outputting the plurality of the advertisement messages can be performed, as claimed. Rather, in col. 18, line 38 - col. 19, line 9, Zigmond mentions feeding cross-over links such an Internet link that may be related to a video program. The Examiner has not shown where Zigmond teaches that the cross-over links comprise: "receiving additional video data from the digital television service provider," as claimed. Internet links or program description are not video data. Further, the Examiner has not shown where Zigmond discloses: "outputting the additional video data without outputting the plurality of the advertisement messages," as claimed. Zigmond says nothing about not displaying advertisement messages, to show additional video, as claimed.

Further, it is respectfully submitted that the Examiner is reading information in Zigmond that has nothing to do with the claimed limitations of limiting a duration that the step of outputting the additional video without outputting the plurality of the advertisement messages can be performed, as claimed. As discussed, Zigmond says nothing about not displaying advertisement messages, to show additional video, as claimed. Further, change in program descriptions in Zigmond has nothing to do with limiting display duration of additional received video.

Claim Rejections Under 35 U.S.C. 103(a)

Claims 5, 12-13 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of U.S. Patent Application publication 20020010927 (Kim, U.S. Application Ser. No. 09/759,721). Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of U.S. Patent Application publication 20020010927 (Kim, U.S. Application Ser. No. 09/759,721), and further in view of Gupta and Dimitrova.

Rejection of Claims 5 and 12-15 under 35 U.S.C. 103(a) is respectfully traversed because the references, alone or in combination, do not disclose all of the claimed limitations. Further, U.S. Patent Application publication 20020010927 (Kim, U.S. Application Ser. No. 09/759,721) was invented by employees of Samsung Electronics Co., Ltd., and the inventors assigned the original application to Samsung Electronics Co., Ltd., as set forth in the Patent Assignment

recorded at Reel/Frame 011466/0440. The above-captioned patent application (Ser. No. 10/021,129) was also invented by employees of Samsung Electronics Co., Ltd., and the inventors assigned the captioned patent application as set forth in the Patent Assignment recorded at Reel/Frame 012400/0700. Applicant certifies that the subject matter of U.S. Patent Application publication 20020010927 (Kim, U.S. Application Ser. No. 09/759,721) and the claimed invention of the above-captioned application (Ser. No. 10/021,129) were, at the time the claimed invention of the captioned application was made, owned by or subject to an obligation of assignment to Samsung Electronics Co., Ltd. Subject matter developed by another person, which qualifies as prior art only under one or more of sections (e), (f) and (g) of Section 102, shall not preclude patentability under Section 103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. 103(a). As a result, U.S. Patent Application publication 20020010927 (Kim, U.S. Application Ser. No. 09/759,721) cannot be used to sustain the rejections in the Office Action. Therefore, Applicant respectfully requests that the rejection of Claims 5, 12-15 should be withdrawn. If U.S. Patent Application publication 20020010927 (Kim, U.S. Application Ser. No. 09/759,721) is not removed as a reference, Applicant reserves the right to present further arguments in support of allowability of Claims 5, 12-15.

Rejection of Claims 9-11 under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Gupta, and further in view of Dimitrova, is respectfully traversed because at least for the

following reasons the references, alone or in combination, do not disclose all of the claimed limitations.

As per **Claim 9**, as discussed, Zigmond fails to teach all of the limitations of base Claims 1 and 8. Further, as the Examiner also states, Zigmond does not disclose limitations of Claim 9. However, the Examiner states that Gupta and Dimitrova disclose such limitations, and that it would have been obvious to one of ordinary skill in the art to combine the references. Applicant respectfully traverses that Gupta and Dimitrova disclose the claimed limitations, and further traverses their combination. No prima facie obviousness has been established. Both Gupta and Dimitrova are non-analogous art.

It is well settled that the reference itself must suggest the modification or combination proposed in order for the modification or combination to be valid; “[the] invention cannot be found obvious unless there was some **explicit** teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention.” *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). “The prior art **must provide** one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound.” *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). There is no suggestion from either reference that they be combined or modified as proposed by the Office Action and, in

fact, even the Office Action fails to provide the necessary impetus for the modification. In addition, as illustrated through more detailed examples below, the references teach away from Applicant's claimed invention and do not provide any suggestion for their combination or modification.

Despite the Examiner's interpretation, Gupta ([0074], [0078],[0085], relied on by the Examiner) does not disclose: initializing a counter to a predetermined value, and incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed, as claimed. Rather, according [0074] of Gupta, if an advertisement is rendered, then time counter since last advertisement is set to 0. Then in [0078] Gupta measures *amount of time since last advertisement*, and does not increment a time counter measuring *duration of advertisement and video output*, as claimed. Then [0085] Gupta states that of advertisements are to be rendered, when the time between advertisements reaches a maximum duration, then another advertisement is rendered and the counter is initialized Gupta does not use duration of advertisement and video output, as claimed, rather Gupta uses duration of time where there are no advertisements. As such, clearly Gupta teaches away from the claimed limitations.

Despite the Examiner's interpretation, Dimitrova (col. 7, lines 8-19) does not disclose: decrementing the counter by an amount corresponding to an amount of time that the step of

outputting the additional video without outputting the plurality of the advertisement messages is being performed; and when the counter reaches the predetermined value, discontinuing the step of outputting the additional video without outputting the plurality of the advertisement messages, as claimed. Dimitrova has nothing to do with the claimed limitations. Indeed, in col. 7, lines 8-19, Dimitrova states:

“The above-noted counter for the signatures on a found commercial list can be monitored to determine how frequently it is incremented, and the results used to provide further commercial identification information. For example, if the counter is incremented within a relatively short period of time, on the order of about 1-5 minutes, it is probably not a commercial. As another example, if the counter is not incremented for a very long time, e.g., on the order of a week or more, then the counter may be decremented, such that the commercial is eventually ‘forgotten’ by the system. This type of temporal relationship policy can also be implemented for the signatures on the above-noted probable lists.”

As is glaringly obvious from the above-quoted passage, the counter referenced in Dimitrova is a commercial *frequency* counter (col. 6, lines 64-66), and not a commercial *time* counter, as claimed. Further, there is mention whatsoever of decrementing a time counter, as claimed, since in Dimitrova the commercial frequency counter is decremented if it has not been incremented for a very long time. There is no step in Dimitrova when the counter reaches the

predetermined value, discontinuing the step of outputting the additional video without outputting the plurality of the advertisement messages, as claimed. The Examiner has simply referred to irrelevant sections in the references to reject the claims. No prima facie case of obviousness has been established. As such, one of ordinary skill in the art will not look to Gupta and/or Dimitrova for achieving the limitations which the Examiner erroneously interprets each reference to disclose.

Further, Applicant respectfully submits that the Office Action is improperly using “hindsight” and the teachings of Applicants’ own claimed invention in order to improperly combine the references in an attempt to render Applicants’ claims obvious, even though the references do not disclose the claimed limitations. The Office Action admits that Zigmond fails to teach all of the limitations of Applicant’s claimed invention. However, the Office Action improperly attempts to modify and combine Gupta and Dimitrova, which also fail to teach the limitations of Applicants’ claimed invention, with Zigmond in an attempt to achieve Applicants’ claimed invention.

On page 10 of the Office Action (third full paragraph), the Examiner has relied on Kim (U.S. Patent Application publication 20020010927) in rejection of Claim 9. As discussed about, Kim (U.S. Patent Application publication 20020010927) cannot be used to reject the claims herein under 35 USC 103(a).

For at least these reasons, it is respectfully submitted that rejection of claim 9, and all claims dependent therefrom, should be withdrawn.

CONCLUSION

For these and other reasons, it is respectfully submitted that the rejection of the rejected claims should be withdrawn, and all of the claims be allowed. Accordingly, reexamination, reconsideration and allowance of all the claims are respectfully requested.

Please charge any deficit or credit any surplus to our Deposit Account No. 01-1960. A duplicate copy of this page is enclosed for this purpose.

<p align="center"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June <u>26</u>, 2006.</p> <p>By: <u>Sarah A. Nielsen</u> <u>Jo Ann Breen</u></p> <p><u>Jo Ann Breen</u> Signature <u>6/26/06</u></p>
--

Respectfully submitted,

Kenneth L. Sherman (Date) 6/24/06
Registration No. 33,783
Myers Dawes Andras & Sherman, LLP
19900 MacArthur Blvd., 11th Floor
Irvine, CA 92612
(949) 223-9600
(949) 223-9610 – Fax
Customer No.: 23386